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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/244,163	02/04/1999	HIDENORI SHIOTSUKA	35.C13307	3414

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT PAPER NUMBER

2826

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/244,163

Applicant(s)

SHIOTSUKA ET AL.

Examiner

Alexander O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,25-27,51,55,56 and 73-76 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-3,9-11,17,20,21,23-27,33-35,41,44,45,47,48,51,55,56,59,63 and 73-80.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 9-11,17,20,21,23,24,33-35,41,44,45,47,48,59,63 and 77-80.

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Serial Number: 09/244163 Attorney's Docket #: 35.C13307

Filing Date: 2/4/99;

Applicant: Shiotsuka et al.

Examiner: Alexander Williams

The indicated allowability of claims 1 and 75 are withdrawn in view of the newly discovered reference(s) to Komori et al. Rejections based on the newly cited reference(s) follow.

Applicant's Amendment in Paper # 19, filed 5/16/02 has been acknowledged.

This application contains claims 9-24, 33-48 and 57-64 drawn to an invention non-elected without traverse in Paper No. 6. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (see 37 CFR § 1.144 & MPEP § 821.01).

Now, claims 4-8, 12-16, 18, 19, 22, 28-32, 36-40, 42, 43, 46, 49, 50, 52-54, 56-62 and 64-72 have been canceled.

Newly submitted claims 77 to 80 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A method or process according to previous claim(s).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 77 to 80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 25-27 and 73-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Komori et al. (U.S. Patent # 5,728,230).

For example, in claim 1 and similar claim 25, Komori et al. (figures 1 to 3) specifically figure 3 show a discloses a semiconductor device comprising a substrate **306**, a filler **302**, an exfoliative layer (**305, a polycarbonate film, see column 8, line 42-45 and column 9, lines 1-5**) and a semiconductor element **301** which is detachable from the substrate, wherein the exfoliative layer comprises an electron ray resin (**The polycarbonate film is inheritly an “exfoliative layer” that is “electron ray degradable resin” because it is the same material that is disclosed as being as described in the specification, on page 21, line 8 and in claim 75, lines 14-34**). Because the film 305 is located between the substrate 306 and the “element” 301, the element 301 is inheriitly detachable. In other words, the function implied by the terminology used in reciting the “exfoliative” layer is inheritly met by layer 305 because it is the same material and finding a new property for something that is old does not render the claim patentable.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to claims 51 and 55, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims 51, 55 and 73-76 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Komori et al. (U.S. Patent # 5,728,230).

For example, in claim 51, Komori et al. (figures 1 to 3) specifically figure 3 show a discloses a semiconductor device comprising a substrate **306**, a filler **302**, an exfoliative layer (**305, a polycarbonate film, see column 8, line 42-45 and column 9, lines 1-5**) and a semiconductor element **301** which is detachable from the substrate, wherein the exfoliative layer comprises an electron ray resin (**The polycarbonate film is inherently an "exfoliative layer" that is "electron ray degradable resin" because it is the same material that is disclosed as being as described in the specification, on page 21, line 8 and in claim 75, lines 14-34**). Because the film 305 is located between the substrate 306 and the "element" 301, the element 301 is inherently

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detachable. In other words, the function implied by the terminology used in reciting the "exfoliative" layer is inherently met by layer 305 because it is the same material and finding a new property for something that is old does not render the claim patentable.

As to the grounds of rejection under section 103, see MPEP § 2113.

Field of Search	Date
U.S. Class and subclass: 257/433,466,459,632,787,788,790 136/249,257,251,285,256,244,259,291,286 438/64,66	12/2/01 8/15/02 11/3/03
Other Documentation: foreign patents and literature in 257/433,466,459,632,787,788,790 136/249,257,251,285,256,244,259,291,286 438/64,66	12/2/01 8/15/02 22/3/03
Electronic data base(s): U.S. Patents EAST	12/2/01 8/15/02 11/3/03

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.

Any inquiry concerning this communication or any earlier communication from the examiner should be directed to ***Examiner Alexander Williams*** whose telephone number is ***(703) 308-4863***.

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Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 receptionist** whose telephone number is **(703) 308-0956**.

11/4/03

A handwritten signature in black ink, appearing to read 'A. Williams', with a long, sweeping horizontal stroke extending to the right.

Primary Examiner
Alexander O. Williams